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| 10/725,205 | 12/02/2003 | Bridget Mary Pantaleo | 67389-034 | 4686 |
| 20277 7590 11/23/2007 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096 | | | EXAMINER STERRETT, JONATHAN G | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|----------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/725,205 | Applicant(s) PANTALEO ET AL. | |
| | Examiner Jonathan G. Sterrett | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-21, 30-40 and 47-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-21, 30-40, 47-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a **Final Office Action** in response to the applicant's response filed September 12, 2007. **Claims 9-21, 30-40 and 47-59** are pending.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Response to Arguments

2. The applicant's arguments have been fully considered but are not persuasive.

3. The applicant argues that the priority to the preceding application (Clarke 09/837807) is unfounded because Clarke fails to disclose a financial institution. In further support of this argument, the applicant states that calling a production facility a financial institution is a "stretched contention". Additionally, the applicant argues that the term "financial institution" has been amended into the claim such that the tasks

claimed are positively recited such that they differ from the teachings of the cited references.

The examiner respectfully disagrees.

Amended Claim 9 is shown below. The examiner has highlighted the "intended use" portions of the claim.

9. (Currently amended) ~~[[The]]~~ A capacity planning method of claim 1, further comprising ~~[[the]]~~ machine-executed steps of:

identifying a plurality of tasks for performance by a financial institution;

identifying a plurality of subtasks associated with each respective one of the plurality of identified financial institution tasks, needed for performance of the respective financial institution task;

accessing production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks;

calculating a total work volume for the tasks for performance by the financial institution,

based on the identified subtasks and the production rate information for the identified subtasks;

accessing staff information;

determining staff availability based on the staff information; and

generating a capacity report report based on the total work volume for the tasks for

performance by the financial institution and the staff availability;

The use of the term "for" preceding the phrases highlighted above make the limitations intended use. As an example, citing "identifying a plurality of tasks for performance by a financial institution" does not patentably distinguish over tasks identified "for a medical facility"; or "for a non-profit institution" because the functional limitation in the claim is "identifying". The same analysis applies to the other "intended use" limitations in the claim. A recitation of the intended use of the claimed invention

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must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, there is no positive recitation in the claim regarding the tasks such that the identifying, identifying, accessing, determining and generating steps regarding tasks and subtasks distinguish over the tasks and subtasks in the cited prior art. For example, the claims recite calculating a total work volume 'for performance by the financial institution' based on the identified subtasks and the production rate information for the identified subtasks. The functionality claimed here is not patentably distinguished over any other business that calculates a total work volume based on all of the tasks and associated subtasks that the business must perform. The fact that this claim limitation cites "for a financial institution" is not patentably distinct over another business that performs a total work volume calculation based on tasks and subtasks.

Additionally the applicant's specification does not set forth a definition for "financial institution" with the required clarity, deliberateness and precision as to what a "financial institution" is. The examiner has set forth in the record a definition as to what a "financial institution" is according to a "broadest reasonable interpretation"¹. The analysis set forth previously in the record as to what a "financial institution" is in accordance with this mode of claim interpretation. The examiner's position is that the terms "financial institution" is a very broad term, and according to a broadest reasonable interpretation, would include any institution whose activities involve or relate to money

(i.e. finance). In response to the applicant's comments about the USPTO and the CIA being "financial institutions", according to a "broadest reasonable interpretation", these institutions are, in fact, "financial institutions".

4. The applicant's arguments have been fully considered regarding new claims 57-59, however, these are moot in view of new grounds of rejection.

Claim Objections

5. Claim 57 is objected to because of the following informalities: Claim 57 depends on Claim 1. Claim 1 has been cancelled. However, since the limitations of Claim 1 have been rolled into Claim 9, for purposes of examination the examiner assumes that the applicant meant for Claim 57 to depend on Claim 9. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹ "Absent an express definition in their specification [*i.e.* lexicography], the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

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6. Claims 9-12, 15, 20-21, 30-34, 37, 39-40, 47-50, 53, and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 2006/0053043) in view of Morgan et al (US 5,799,286).

As per claims 9, 30 and 47, Clarke teaches receiving a plurality of tasks (paragraph 8, where the system can be used for receiving a plurality of tasks and the work breakdown structure records all tasks and subtasks related to the project.); identifying a plurality of subtasks associated with each of the plurality of received tasks, wherein the identified subtasks are of different types and are needed to perform each respective task (paragraph 74 elaborates further as to the use of subtasks which represent the "logical steps that must be performed to finish the job"); accessing production rate information related to the amount of time (paragraph 88, where Clarke teaches it is difficult to improve productivity if you cannot measure it, wherein the system tracks productivity as it measures project efficiency, as indicated in paragraph 72. In order to measure project efficiency, the production rate would need to be determined), and calculating a work volume based on the identified subtasks and the production rate information (paragraph 85, where the system focuses on improving a combination of maintenance operation volume management and resource management to improve the facility, whereby improving volume management would require knowing the work volume).

Clarke teaches task management in a manufacturing organization. Clarke does not expressly teach the specific data recited in claims 9, 30 and 47; however, these

differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.

However, Official Notice is taken that task management is utilized in the nonfunctional data (i.e. financial institutions) since it is known to improve the management of the operation of an organization.

It would have been obvious to one ordinary skill in the art to modify the teachings of Clarke, to include the step of providing task management to a financial institution, because it would improve the operational efficiency of the organizations.

The examiner notes that the term "financial institution" is non-functional descriptive material and does not add patentable weight to the claim (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.)

Furthermore, as per claims 9, 30-31 and 47, Clarke teaches accessing staff information; determining staff availability based on the staff information; and the staff

information is related to one of: the number of employees, capability of a specific employee to perform the subtasks, information related to exempt status of employees, information related to staff outage, information related to work time that cannot be used to perform the subtasks, and information related to business days within a specific period of time (See Figure 7, where the employee schedule is displayed. The breaks listed would constitute time the employee is unavailable to work or perform tasks. This would indicate the availability of the employee and would require accessing in order to view the information.).

Clarke does not explicitly teach a capacity report. Morgan teaches that it is known to generate a capacity report based on the work volume and the staff availability (column 19, lines 35-51: "User-profile Reporting" where the availability of the employee is reported as well as the production or work volume as indicated by the Activity Output Report, where output is equivalent to work volume as it performs an identical function in substantially the same manner with substantially the same results). Morgan is an analogous art as it also teaches about project management and workflow concerning tasks. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management system of Clarke with the capacity report feature of Morgan to provide a means of measuring the manpower required for tasks which can be targeted for reduction to help improve efficiency and optimize resource allocation.

As per claims 10, 32 and 48, Clarke does not explicitly teach information about employees. Morgan teaches that it is known the information related to the number of employees includes at least one of the number of full-time employees, the number of other types of employees, the total hours worked by other types of employees expressed as a full-time employee equivalent (column 17, lines 33-41, where the full-time equivalents (FTE) are reported with respect to each product and its cost. The FTE would indicate the number of employees.); and the other types of employees include at least one of part-time employees, temporary employees, interns, and borrowed staff (column 6, lines 1-2 where employees include contractors, consultants and temporary workers). Morgan is an analogous art as it also teaches about project management and workflow concerning tasks. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management system of Clarke with the number of FTE feature of Morgan to provide a means of measuring the manpower required for tasks which can be targeted for reduction to help improve efficiency.

As per claims 11, 33 and 49, Clarke teaches the step of calculating extended staff availability by considering extended work hours. Official notice is taken that it is old and well known that companies have second shift and sometimes third shifts to extend their staff and the work hours in order to meet production goals. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management database of Clarke with an extended staff and extended hours feature to provide a means for increasing staff and work hours to meet production requirements. One such reference that teaches this concept is "The General Employee Scheduling

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Problem: An Integration of MS and AI" by Glover et al, Computer & Operations

Research, vol 13, no 5, p. 563-573, 1996.; Clarke does not explicitly teach a capacity report. Morgan teaches that it is known the capacity report is generated further based on the extended staff availability (column 19, lines 35-51: "User-profile Reporting" where the availability of the employee is reported as well as the production or work volume as indicated by the Activity Output Report, where output is equivalent to work volume as it performs an identical function in substantially the same manner with substantially the same results. The extended staff is included in the employees as noted in column 6, lines 1-2.). Morgan is an analogous art as it also teaches about project management and workflow concerning tasks. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management system of Clarke with the capacity report feature of Morgan to provide a means of measuring the manpower required for tasks which can be targeted for reduction to help improve efficiency and optimize resource allocation.

As per claims 12, 34 and 50, Clarke teaches the extended staff availability is calculated based on a plurality of overtime scenarios or a plurality of expanded staff scenarios (Official notice is taken that it is old and well known that companies have second shift and sometimes third shifts, or expanded staff scenarios, to extend their staff and the work hours in order to meet production goals. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management database of Clarke with an extended staff and extended hours feature to provide a means for increasing staff and work hours to meet production requirements.

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One such reference that teaches this concept is "The General Employee Scheduling Problem: An Integration of MS and AI" by Glover et al, Computer & Operations Research, vol 13, no 5, p. 563-573, 1996.).

As per claims 15, 37 and 53, Clarke teaches the work volume is calculated (paragraph 85, where the system focuses on improving a combination of maintenance operation volume management and resource management to improve the facility, whereby improving volume management would require knowing the work volume). Clarke does not explicitly teach work volume being calculated as the number of time units needed to perform the identified subtasks. Morgan teaches that it is known that work volume is calculated as the number of time units needed to perform the identified subtasks (column 6, lines 17-19, where the time tracking application is used to measure utilization which is incorporated to calculate production and column 3, lines 60-61, where there is a production measurement system (36) which is equivalent to determining production rate information as it performs an identical function in substantially the same manner with substantially the same results and column 8, lines 5-9, where in relation to production measurement, product volumes are determined and entered). Morgan is an analogous art as it also teaches about project management and workflow concerning tasks. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management system of Clarke with the number of subtasks/time feature of Morgan to provide a means of measuring the rate of task performance which can be targeted for reduction to help improve efficiency.

As per claims 20, 39 and 55, Clarke teaches the staff availability is calculated based on at least one of the number of employees, the information related to staff outage, the information related to the amount of work time that cannot be used to perform the subtasks, the information related to business days, and the amount of defined work hours per day (See Figure 7, where the employee schedule is displayed. The breaks listed would constitute time the employee is unavailable to work or perform tasks. This would indicate the availability of the employee and would require accessing in order to view the information.).

As per claims 21, 40 and 56, Clarke teaches the information related to the amount of work time that cannot be used to perform the subtasks depends on at least one of the position, the identity, the exempt status, the handling capability, and the outage status of the respective employee (See Figure 7, where the employee schedule is displayed. The breaks listed would constitute time the employee is unavailable or outage time with respect to being able to work to perform tasks.)

As per Claims 57-59, Clarke does not teach where the financial institution is a bank, a clearing house, a clearing center or an insurance company.

However, Official Notice is taken that it is old and well known in the art for a financial institution to be a bank. It is further well known that bank personnel are involved with performing tasks according to their responsibilities.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Clarke and Morgan, regarding providing for task

management, to include the step of providing the task management for a bank, because it would provide a predictable result through applying the task management teachings to the employees of a bank.

7. Claims 13-14, 16-19, 35-36, 38, 51-52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 2006/0053043) in view of Morgan et al (US 5,799,286) in further view of Thompson (US 7,020,619).

As per claims 13, 35 and 51, Clarke does not explicitly teach comparing work volume with the staff and then with the extended staff. Thompson teaches that it is known that the capacity report is generated based on a first comparison between the work volume and the staff availability, and a second comparison between the work volume and the extended staff availability (column 13, lines 31-34, where monitoring productivity allows an operation to compare scheduled workload with the available human resources and column 14, lines 20-21 where the cost effectiveness of outsourcing or using extended staff for work is determined.). Thompson is an analogous art as it also teaches about an activity based management system. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Clarke with the comparison of staff to extended staff feature of Thompson to provide a more detailed analysis of human capital cost.

As per claims 14, 36 and 52, Clarke does not explicitly teach warnings. Thompson teaches that it is known to generate warnings based on the first comparison and the second comparison (column 15, lines 1-40, where the value of the cost-value

indicates whether using outsourced or extended staff resources is cost competitive or if the product should be made internally. If the value is negative, costs would be saved by outsourcing the work. This is equivalent to a warning as it performs an identical function in substantially the same manner with substantially the same results). Thompson is an analogous art as it also teaches about an activity based management system.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Clarke with the warning feature of Thompson to provide a more user-friendly system that is easy-to-use.

As per claims 16, 38 and 54, Clarke does not explicitly teach calculating work time. Thompson teaches that it is known that the total amount of time that employees can perform the subtasks within the specific period of time is calculated by using the equation of: (the number of employees) · (the number of standard work hours per day) · (the number of business days within the specific period of time) - (the amount of time lost due to staff outage within the specific period of time) - (the amount of work time that cannot be used to perform the subtasks within the specific period of time) (column 3, lines 36-67 and column 4, lines 1-3, where the system determines the start time and cycle and intervals required to complete the tasks for each project). Thompson is an analogous art as it also teaches about an activity based management system.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Clarke with the work time calculation feature of Thompson to provide an efficient means for determining available work time.

As per claim 17, Morgan teaches the capacity report is generated further based on the extended staff availability (column 19, lines 35-51: "User-profile Reporting" where the availability of the employee is reported as well as the production or work volume as indicated by the Activity Output Report, where output is equivalent to work volume as it performs an identical function in substantially the same manner with substantially the same results. The extended staff is included in the employees as noted in column 6, lines 1-2.); the step of calculating extended staff availability by considering extended work hours (column 6, lines 1-5, where each employee, including the extended staff, has their activity percentage data calculated for their respective job. Indicating activity status would also indicate availability when activity status is zero or no value is indicated. Official notice is taken that it is old and well known that companies have second shift and sometimes third shifts, or expanded staff scenarios, to extend their staff and the work hours in order to meet production goals. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management database of Morgan with an extended staff and extended hours feature to provide a means for increasing staff and work hours to meet production requirements. One such reference that teaches this concept is "The General Employee Scheduling Problem: An Integration of MS and AI" by Glover et al, Computer & Operations Research, vol 13, no 5, p. 563-573, 1996.).

As per claim 18, Morgan teaches the extended staff availability is calculated based on a plurality of overtime scenarios or a plurality of expanded staff scenarios (Official notice is taken that it is old and well known that companies have second shift

and sometimes third shifts, or expanded staff scenarios, to extend their staff and the work hours in order to meet production goals. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management database of Clarke with an extended staff and extended hours feature to provide a means for increasing staff and work hours to meet production requirements. One such reference that teaches this concept is "The General Employee Scheduling Problem: An Integration of MS and AI" by Glover et al, Computer & Operations Research, vol 13, no 5, p. 563-573, 1996.).

As per claim 19, Clarke teaches the capacity report includes a cost analysis (paragraph 66: "FIGS. 9 and 10 are used to create categories of resources in order to define people, skill sets, experience levels, cost, and availability.").

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on Monday through Friday, 10 am to 8 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JGS/

11-13-07


ROMAIN JEANTY
PRIMARY EXAMINER
Art Unit 3623